

REMARKS

Claims 18 and 20 are canceled without prejudice, claims 21 to 24 are added, and therefore claims 11 to 17, 19 and 21 to 24 are currently pending.

Reconsideration of the application is respectfully requested based on the following remarks.

With respect to paragraph 1 of the Office Action, the information disclosure statement (IDS) filed on June 17, 2005, was indicted as failing to comply with 37 C.F.R. § 1.98(a)(2) and 37 C.F.R. § 1.98(a)(3). It is respectfully submitted that under M.P.E.P. 609.03, the Examiner must consider all references in International Search Report, and that the translation and relevancy requirement are satisfied by the International Search Report. Nevertheless, to facilitate matters, submitted herewith is a copy of the originally submitted IDS, and copies of all of the references cited therein. As to 37 C.F.R. § 1.98(a)(3), the International Search Report (ISR) (which was also submitted on June 17, 2005) explains the relevance of each of the references cited in the IDS, including the page and line numbers for the references of particular relevance (i.e., those marked with an X in the ISR) and a Search Authority indication for other references as being evidence of the general state of the art (i.e., those marked with an A in the ISR). The ISR relevance explanation satisfies the request.

With respect to paragraph 2 of the Office Action, claims 11 to 20 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,090,247 to Liebgen (hereinafter the "Liebgen" reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the

Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Independent claim 11, as presented, is to *a pressure sensor comprising: a pressure sensor element having a diaphragm area; and a first fixing area, a pressure to be measured exerting a force action on the diaphragm area, the first fixing area being connected to a second fixing area of a fixing element to fix the pressure sensor element; in which the first fixing area and the second fixing area are pressure-loaded by the force action, and in which a cross section of the fixing element tapers, at the second fixing area, at an angle to a sensing plane of the diaphragm area.*

The “Liebgen” reference does not identically disclose (or even suggest) at least the above-identified claim features. Specifically, the “Liebgen” reference does not identically disclose (or even suggest) the features of a pressure sensor having a pressure sensor element and a fixing element, wherein a cross-section of the fixing element, at a second fixing area connected to a first fixing area of the pressure sensor element, is tapered at an angle to a sensing plane of a diaphragm area of the pressure sensor element. Instead, FIG.1 of the “Liebgen” reference only indicates that step 38 of support element 34 is parallel to diaphragm 20 of pressure sensor 10. Therefore, because step 38 is parallel to diaphragm 20, the “Liebgen” reference does not identically disclose (or even suggest) the tapered cross-section of the fixing element at the second fixing area, as provided for in the context of the claimed subject matter.

Therefore, the features of claim 11, as presented, including the features identified above, are not identically disclosed (or suggested) by the “Liebgen” reference. Accordingly, claim 11, as presented, is allowable, as are its dependent claims. It is therefore respectfully requested that the anticipation rejections of claims 11 to 20 be withdrawn.

With respect to newly added claims 21 to 24, these claims do not add any new matter and are supported by the present application. Claims 21 to 24 are allowable over the cited

references at least because they depend from independent claim 11, which is allowable at least for the reasons discussed above.

Accordingly, claims 11 to 17, 19 and 21 to 24 are allowable.

CONCLUSION

Applicants respectfully submit that all pending claims of the present application are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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